

AO 120 (Rev. 2/99)

TO: Mail Stop 8 Director of the U.S. Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been
 filed in the U.S. District Court Northern District of California on the following ☐ Patents or ☒ Trademarks:

DOCKET NO. CV 11-00927 LB	DATE FILED February 28, 2011	U.S. DISTRICT COURT Northern District of California, 1301 Clay Street, Rm. 400s, Oakland, CA 94612
PLAINTIFF VDX INC.		DEFENDANT VETERINARY DIAGNOSTICS INSTITUTE, INC.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 3,008,890		SEE ATTACHED
2 3,220,027		
3 3,244,450		
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
1		SEE ATTACHED	
2			
3			
4			
5			

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK Richard W. Wieking	(BY) DEPUTY CLERK	DATE
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Copy 1—Upon initiation of action, mail this copy to Commissioner Copy 3—Upon termination of action, mail this copy to Commissioner
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner Copy 4—Case file copy

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NORTHERN DISTRICT OF CALIFORNIA

1
2 Joseph J. Zito (jjzito@zitotlp.com)
3 ZITO tlp
4 1250 Connecticut Avenue, NW
5 Suite 200
Washington, D.C. 20036
P: (202) 466-3500

E-filing

6 Richard B. Vaught (State Bar Number: 112155)
7 rvaught1@sbcglobal.net
8 The Law Office of Richard B. Vaught
9 111 West St. John, Suite 500
San Jose, CA 95113
P: 877-732-9216

ADR

10 IN THE UNITED STATES DISTRICT COURT
11 FOR THE NORTHERN DISTRICT OF CALIFORNIA

12 VDX, Inc.
13 2019 Anderson Road, Suite C
14 Davis, CA 95616

15 Plaintiff

16 v.

17 Veterinary Diagnostics Institute, Inc.
18 4685 Runway Street, Suite K
Simi Valley, CA 93063

19 Defendant
20

C V 11 - 0927

Civil Action No.

LB

COMPLAINT FOR TRADEMARK
INFRINGEMENT

21 Plaintiff VDX, Inc ("VDX") by and through undersigned counsel, for its Complaint
22 against Defendant Veterinary Diagnostics Institute, Inc ("Veterinary Institute"), states as follows:
23

24 PARTIES

25 1. Plaintiff VDX, Inc. is a California Corporation having its principal office and
26 place of business at 2019 Anderson Road, Suite C, Davis, CA 95616.
27
28

1. Plaintiff VDX, Inc. is a California Corporation having its principal office and place of business at 2019 Anderson Road, Suite C, Davis, CA 95616.

2. Upon information and belief, Defendant Veterinary Diagnostics Institute, Inc. is a California Corporation having its principal place of business at 4685 Runway Street, Suite K , Simi Valley, CA 93063.

JURISDICTION AND VENUE

3. This is an action for trademark infringement under the Lanham Act, 15 U.S.C. §1051 *et seq*; 15 U.S.C. § 1114; unfair competition under 15 U.S.C. § 1125(a)(1), and trademark dilution under 15 U.S.C. 1125(c).

4. This Court has jurisdiction over the subject matter of this action pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, and 1338 (a) and (b), and has supplemental jurisdiction under 28 U.S.C. § 1367(a) over VDX's California law claims. Upon information and belief, Defendant maintains a presence on the World Wide Web through its website <http://www.vdxinstitute.com> by which it markets its products and services and solicits business and through which, amongst other operations, a customer can purchase laboratory testing services. Personal jurisdiction in this district is proper inasmuch as Defendant has solicited and conducted business within the State of California, Northern District via its website, thereby purposely availing itself of the privilege of acting in the State of California, Northern District.

5. A substantial part of the events giving rise to the claim occurred or a substantial part of property that is the subject of this action is situated in the Northern District of California. Defendant has infringed VDX trademark rights in the Northern District of California and throughout the United States and has caused confusion and diminution in the value of VDX's

1 mark in the Northern District of California and throughout the United States. Venue is proper in
2 the Northern District of California pursuant to 28 U.S.C. § 1391(b) (2).
3
4
5

6 **FACTS**

7 6. VDX was incorporated in 2001, and has since been providing diagnostic and
8 cytology services to the veterinary community, as well as medical research and histology services
9 under the registered trademark VDX®.
10

11 7. On October 25, 2005, VDX obtained registration of the mark "VDX" on the
12 principal register of the United States Patent and Trademark Office (USPTO), Registration No.
13 3,008,890 (registration filed in 2004, first use May 7, 2001; first use in commerce July 13,
14 2001). See as Exhibit A, certificate of registration of the VDX® mark. The registration covers
15 veterinary services, veterinary consulting, veterinary diagnostic testing and veterinary laboratory
16 research. The certificate of registration of the VDX® mark is *prima facie* evidence of the validity
17 of the registration, of Plaintiff's ownership of the mark, and of Plaintiff's exclusive right to use
18 the mark in commerce in connection with the goods and services specified in the certificates of
19 registration under the provisions of 15 U.S.C. § 1057(b), and provides constructive notice of the
20 Registrant's claim of ownership under 15 U.S.C. § 1072. In addition, Registration No. 3,008,890,
21 satisfies the statutory requirements for incontestability and has been recognized by the United
22 States Patent and Trademark Office as incontestable under Section 15 of the Trademark Act, 15
23 U.S.C. § 1065, on January 15, 2011 (attached as Exhibit B Notice of Acceptance and
24 acknowledgment by the United States Patent and Trademark Office).
25
26

27 8. Since its inception, VDX has been recognized for its commitment to the highest
28 level of diagnostic quality and reliability and has made significant investments to establish its

1 market recognition, including the use of the mark VDX® in connection with the services that it
2 provides to the veterinary industry.

3
4 9. Since obtaining the trademark for the mark VDX® in 2005, VDX has been
5 continuously using the mark and increasing its market recognition and has continued to invest in
6 the mark. These efforts by VDX have caused the mark VDX® and variants thereof to become
7 well known and widely recognized and associated with Plaintiff.

8
9 10. On May 6, 2010, VDX filed two additional trademark applications on the
10 principal register of the USPTO: VDX with serial number 85/032,193 and VDX and design with
11 serial number 85/032,170 for veterinary services in international class 44 (first use May 7, 2001,
12 and first use in commerce, July 13, 2001) and medical, scientific research and medical laboratory
13 services, particularly pathology in international class 42 (first use August 6, 2001 and first use in
14 commerce June 28, 2002).

15
16 11. Upon information and belief, Defendant Veterinary Institute was incorporated in
17 2006, and provides veterinary diagnostics testing services. The goods and services offered by
18 Veterinary Institute are similar to Plaintiff's goods and services, are in the same market as
19 Plaintiff's and are marketed to the same potential customers. Defendant, Veterinary Institute,
20 began using the VDXI mark in 2006 and has not established any market recognition in the mark
21 VDXI.

22
23 12. On March 20, 2007, Defendant Veterinary Institute obtained registration of the
24 mark "VDXI" on the principal register of the USPTO, Registration No. 3,220,027 (registration
25 filed in 2006, first use and first use in commerce March 31, 2006) also for veterinary services,
26 attached as Exhibit C. On May 22, 2007, Defendant obtained registration of the mark "VDXI"
27 and design, on the principal register of the United States Patent and Trademark Office,
28

1 Registration No. 3,244,450, (registration filed in 2006, first use and first use in commerce March
2 31, 2006) also for veterinary services, attached as Exhibit D.

3 13. On February 18, 2011, Plaintiff VDX filed petition to cancel marks Nos.
4 3,220,027 and 3,244,450 with the Trademark Trial and Appeal Board, on the grounds of priority
5 and likelihood of confusion (Trademark Act Section 2(d), and dilution (Trademark Act Section
6 43c).

8 14. The mark VDX has substantial commercial value to Plaintiff and the use of the
9 marks VDXI and VDXI and design by Defendant has caused and/or is likely to cause confusion
10 and/or dilution in the relevant marketplace and continues to cause such confusion

11 15. Before filing suit, Plaintiff VDX contacted Defendant Veterinary Institute
12 regarding the unauthorized use of the mark VDXI. Defendant has continued using its mark
13 despite Defendant's knowledge that such use infringes Plaintiff's rights in its trademarks.
14

16 **COUNT I: DECLARATORY JUDGMENT**

17 16. Plaintiff VDX repeats the allegations above as if fully set forth herein.

18 17. An actual controversy has arisen and now exists relating to the rights and
19 ownership of the "VDX" mark between the parties herein in that Plaintiff contends that it has
20 superior rights to the exclusive use of "VDX" and that the use of the mark "VDXI" "and "VDXI"
21 and design and variants thereof are so similar to the Plaintiff's VDX® mark as to cause
22 confusion in the relevant market.
23

24 18. Plaintiff seeks an Order from this Court declaring that its rights to use the
25 VDX mark are superior to and have priority as against any and all claims which
26 Defendant might assert and that Defendant's marks "VDXI" and "VDXI" and design and
27 variants thereof are likely to confuse the public as to origin or source.
28

19. Plaintiff VDX seeks a declaratory judgment from this Court establishing the following: (1) that Plaintiff VDX owns the VDX mark nationwide; and (2) that Plaintiff has superior rights to the "VDX" mark and variants thereof.

20. Plaintiff VDX further seeks a declaratory judgment from this Court establishing that trademark Registration No. 3,220,027 and trademark Registration No. 3,244,450 are invalid and directing the USPTO to Cancel trademark Registration No. 3,220,027 and trademark Registration No. 3,244,450.

COUNT II
FEDERAL TRADEMARK INFRINGEMENT

21. Plaintiff VDX repeats the allegations above as if fully set forth herein.

22. Defendant's aforementioned acts constitute trademark infringement in violation of the Lanham Act, 15 U.S.C. § 1114.

23. Plaintiff VDX's federal registration on the Principal Register for the mark VDX® has priority over Defendant's use of the mark VDXI.

24. Defendant's wrongful use of the VDX mark and variants thereof has caused and/or is likely to cause confusion, has diluted and/or is likely to dilute and/or destroy or diminish the origin-identifying function of the VDX® mark. Defendant's actions constitute trademark infringement in violation of the Lanham Act, 15 U.S.C. § 1114.

25. As a proximate result of Defendant's actions, Plaintiff VDX has suffered and will continue to suffer damage to its business, goodwill, reputation, profits and the strength of its trademark. The injury to Plaintiff is and continues to be ongoing and irreparable. An award of monetary damages alone cannot fully compensate Plaintiff for its injuries and Plaintiff lacks an adequate remedy at law.

1 26. The foregoing acts of infringement have been and continue to be deliberate,
2 willful and wanton, making this an exceptional case within the meaning of 15 U.S.C. § 1117 and
3 § 1114.

4
5 27. Plaintiff VDX is entitled to a permanent injunction against Defendant, as well as
6 all other remedies available under the Lanham Act, including, but not limited to, compensatory
7 damages; treble damages; disgorgement of profits; and costs and attorney's fees.

8 **COUNT III**
9 **UNFAIR COMPETITION**

10 28. Plaintiff VDX repeats the allegations above as if fully set forth herein.

11 29. The acts of Defendant Veterinary Institute complained of herein constitute unfair
12 competition in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

13 **COUNT IV**
14 **DILUTION OF TRADEMARK**

15 30. Plaintiff VDX repeats the allegations above as if fully set forth herein.

16 31. The acts of Defendant Veterinary Institute complained of herein constitute
17 dilution of the distinctive quality of the VDX® mark, in violation of the Federal Trademark
18 Dilution Act, 15 U.S.C. § 1125(c).

19
20
21 **COUNT V: TRADEMARK INFRINGEMENT UNDER THE COMMON LAW OF**
22 **CALIFORNIA**

23 32. Plaintiff VDX repeats the allegations above as if fully set forth herein.

24 33. The acts of Defendant Veterinary Institute complained of herein constitute
25 trademark infringement in violation of the common law of the State of California.

26 34. The acts of Defendant Veterinary Institute complained of herein constitute unfair
27 competition in violation of the common law of the State of California.

1 35. The acts complained of above by Defendant Veterinary Institute constitute
2 dilution of the distinctive quality of the VDX® mark in violation of the California Anti-Dilution
3 Statute.
4

5 **COUNT VI: APPLICATION FOR**
6 **PRELIMINARY AND PERMANENT INJUNCTION**

7 36. Plaintiff VDX repeats the allegations above as if fully set forth herein.

8 37. Defendant Veterinary Institute has damaged Plaintiff VDX and is continuing to
9 damage Plaintiff VDX by its illegal acts. Unless Defendant Veterinary Institute is restrained by
10 this Court, Defendant Veterinary Institute will cause irreparable injury to Plaintiff VDX for
11 which there is no adequate remedy at law.

12 **JURY DEMAND**

13 38. Plaintiff VDX demands a jury trial in accordance with Fed. R.Civ.P. 38(b).
14
15

16 **PRAYER FOR RELIEF**

17 39. WHEREFORE, Plaintiff VDX prays for judgment against Defendant as follows:

18 (1) that the use of "VDXI" by Defendant infringes Registration No. 3,008,890;

19 (2) that the use of "VDXI" and design by Defendant infringes upon Registration No.
20 3,008,890.

21 (3) that Defendant's marks Nos. 3,220,027 and 3,244,450 should be declared invalid.

22 (4) that Defendant, its officers, agents, servants, employees, and attorneys, and
23 those persons in active concert or participation with Defendant who receive actual notice of the
24 court's order by personal service or otherwise, be permanently enjoined from:

25 (a) using the VDXI and the VDXI and design mark or any variation thereof in
26 connection with veterinary services;
27

28 (b) otherwise competing unfairly with Plaintiff VDX in any manner, including,

1 without limitation (i) unlawfully adopting or infringing upon the VDX[®] mark (ii) diluting,
2 blurring, passing off or falsely designating the origin of goods not lawfully associated with the
3 VDX[®] mark and from injuring Plaintiff VDX's goodwill and reputation;

4
5 (c) doing any other act or thing likely to induce the belief that any product and or
6 service of Defendant is in any way connected with, sponsored, affiliated, licensed, or endorsed
7 by Plaintiff VDX ;

8 (d) using the VDX[®] mark or any variation thereof on the internet, or as
9 domain names, email addresses, meta tags, invisible data, or otherwise engaging in acts or
10 conduct that would cause confusion and/or misdirection as to the source, sponsorship or
11 affiliation of Defendant with Plaintiff.

12
13 (5) that Defendant, in accordance with 15 U.S.C. § 1116(a), be directed to file with
14 this court and serve upon Plaintiff within thirty days after service of the permanent injunction a
15 report in writing under oath, setting forth in detail the manner and form in which Defendant has
16 complied with the permanent injunction;

17
18 (6) that Plaintiff recover its actual damages sustained as a result of Defendant's wrongful
19 actions;

20 (7) that Plaintiff recover Defendant's profits made as a result of Defendant's wrongful
21 actions;

22 (8) that Plaintiff recovers three times Defendant's profits made as a result of Defendant's
23 wrongful actions or three times Plaintiff damages, whichever is greater;

24 (9) that this case be deemed an exceptional case under 15 U.S.C. §§ 1117(a) and (b) and
25 that Defendant be deemed liable for and ordered to reimburse Plaintiff for its reasonable
26 attorneys' fees;
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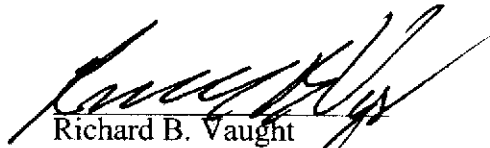
1 (10) that Plaintiff be awarded exemplary damages for Defendant's willful and intentional
2 acts;

3 (11) that Plaintiff recover its costs of court; and
4

5 (12) that Plaintiff recover such further relief to which it may be entitled.

6 Dated: February 22, 2011

7 Respectfully submitted,

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9 
10 Richard B. Vaught
11 The Law Office of Richard B. Vaught
12 111 West St. John, Suite 500
13 San Jose, CA 95113
14 (877) 732 9216
15 rvaught1@sbcglobal.net

16 Joseph J. Zito
17 ZITO TLP
18 1250 Connecticut Ave, NW, Suite 200
19 Washington, DC 20036
20 (202) 466 3500
21 jzito@zitotlp.com

22 *Attorneys for Plaintiff*
23
24
25
26
27
28